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| 10/821,215      | 04/08/2004  | Hongyuan Wang        | 9896-000036/CO      | 9409             |

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| EXAMINER |
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YENKE, BRIAN P

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| ART UNIT | PAPER NUMBER |
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2622

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04/03/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                    |  |
|------------------------------|--------------------------------------|------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/821,215 | <b>Applicant(s)</b><br>WANG ET AL. |  |
|                              | <b>Examiner</b><br>BRIAN P. YENKE    | <b>Art Unit</b><br>2622            |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Response (01/06/09).
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 01/06/09 have been fully considered but they are not persuasive.

#### ***Applicant's Arguments***

a) Applicant states that the examiner mischaracterizes the Dyers reference regarding providing/encoding the video data with caption data for transmittal in claim 1. Applicant cites (col 5, line 22-24 of Dyer) regarding "after the closed caption data has been extracted, the remaining components of the television signal pass to media player encoder 28...

#### ***Examiner's Response***

a) The examiner disagrees. It is noted that Dyer (col 4, line 50-65) discloses that the entire contents of storage device 20 (which includes the caption data) is transmitted, along with the components that are passed through decoder 14 (the video data) to media encoder 28. Encoder 28 merges the data to cause the extracted components to be delivered to the viewer simultaneously with the corresponding unprocessed components" Thus Dyer clearly discloses the providing/encoding of video with caption data.

Regarding applicant's continued assertion that the applied references do not show a mingled image, although the examiner disagrees that Dyer doesn't show this, since obviously to transmit the video and caption data by the encoder so the viewer at the same time, the syncing/multiplexing of the two streams is required, if not how will the video and caption data be aligned/matched.

The examiner will further provide such evidence to expedite prosecution in order to demonstrate this well known technique.

US 6,415,100, Fig 4, shows that video/caption and audio are mingled (i.e. multiplexed together).

US 6,714,720, Fig 3, shows a demultiplexer 80 which receives encoded caption, video and audio data (thus they were previously encoded/mingled/multiplexed together).

US 20010041055, Fig 1, shows multiplexer 8, which mingles the video, audio and caption data.

US 6,963,906 (Fig 5, encoder 62), wherein the disclosure states the URL may be encoded with the video data, just like caption data typically is (emphasis added) (col 8, line 66 to col 9, line 21).

In the event the applicant deems that the mingling/encoding of such data (video and caption) is not known, the examiner would like the applicant to clarify such with respect to the above references. It is noted the examiner has provided references which teach mingling (multiplexing) data which has been separately encoded (US 6,415,100, US 6,714,720 and US 20010041055) and also mingling/encoded data (video and caption) together.

It should be noted these references are only being provided to demonstrate the examiner's previous/current position the encoding/mingling of video and caption data is notoriously well known in the art. In the event the applicant continues to assert that Dyer does not encode/mingle such data (video and caption information), the examiner requests the applicant how the encoder of Dyer is able to send both video and caption data simultaneously to the viewer without mingling/encoding/multiplexing or synchronization such information.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mortensen et al., US 5,563,804 in view of Dyer, US 6,903, 779 and Plog, US 6,414,724.

In considering claim 1, 4 and 7,

Mortensen discloses a system for providing closed captioning to an electronic discussion group. As shown in Figs 1, 2 and 3, users of a discussion group may receive video data via a tuner 1 through a network 6, in addition to receiving closed caption data from the video signal, and wherein the conferees may also receive captions generated from the user's discussion Figs 1a, 2a and 3a.

Regarding the mingling of the caption image on a digital service image, it is noted that Mortensen discloses the transmission of the caption data separately (Fig 1), the video data separately (Fig 2) or the transmission of both the caption data and video data simultaneously (Fig 3) although done separately (i.e. not mingled). Although the concept of transmitting video and caption data together is notoriously well known in the art, since caption data is linked/synchronized with the video data. The examiner will nonetheless evidence this concept of providing/encoding the video data with caption data for transmittal (See Figs 2-4 of Dyer).

Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Mortensen which discloses the simultaneous transmission of video and caption data separately, to transmit them together (i.e. mingled image). as done by Dyer which would provide the conventional benefit of receiving both signals via a single stream/network.

However, the combination of Mortensen/Dyer does not explicitly recite the concept of a transparent background. Although it is noted that in the realm of captioning data, the background is typically made transparent so that user's may view the main program without distortion (i.e. the captioning blocks out the video).

The examiner evidences such conventional practice by incorporating Plog which discloses teletext (caption data) using a transparent background.

Thus it would have been clearly obvious to one of ordinary skill in the art at the time of the invention to modify Mortensen/Dyer which discloses the transmitting/reception/display of video and captioned data (to include discussion between users) to off the user the ability to view the video without obstruction by making the background of the caption data transparent.

In considering claims 2-3,

As discussed above with respect to claim 1, the combination of Mortensen/Dyer/Plog discloses the transparency (color). Regarding the conventional recitations of the codes, position and size, the examiner takes "OFFICIAL NOTICE" since this information is necessary by the display in order to decode/display such captioning data.

In considering claims 5 and 8,

The combination above does not explicitly recite "dot matrix" however this is a conventional format of captioned data, thus the examiner takes "OFFICIAL NOTICE" regarding such. See attached PTO-892 US20030215219.

In considering claims 6, 9-10,

The combination above does not explicitly recite the positions/locations of the CODEC of the caption overlay and caption generating module, however the practice of encoding/decoding in a first path (transmission) and 2<sup>nd</sup> path (reception) both being in the service channel is conventional in the art and thus the examiner takes "OFFICIAL NOTICE" regarding such. See cited references, US 5,508,754 and US 5,343,239.

### ***Conclusion***

**3. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2622

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Yenke whose telephone number is (571)272-7359. The examiner work schedule is Monday-Thursday, 0730-1830 hrs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, David L. Ometz, can be reached at (571)272-7593.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

**(571)-273-8300**

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703)305-HELP.

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/BRIAN P. YENKE/  
Primary Examiner, Art Unit 2622

B.P.Y  
01 April 2009